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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,371	09/20/2006	Jens Maerke	3824	8912
278	7590	09/30/2009		
MICHAEL J. STRIKER 103 EAST NECK ROAD HUNTINGTON, NY 11743			EXAMINER PATEL, VISHAL A	
			ART UNIT 3676	PAPER NUMBER
			NOTIFICATION DATE 09/30/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

striker@strikerlaw.com

### Office Action Summary

**Application No.**

10/593,371

**Applicant(s)**

MAERKLE, JENS

**Examiner**

Vishal Patel

**Art Unit**

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-27 is/are pending in the application.
- 4a) Of the above claim(s) 20-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CD/CC)  
Paper No(s)/Mail Date 9/20/06

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 20-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/17/09.
2. Applicant's election with traverse of restriction in the reply filed on 6/17/09 is acknowledged. The traversal is on the ground(s) that the method of claim 20 and the injection mold for manufacturing the housing part are realized only the housing part of claim 1 can be produce or produce only the housing part of claim 1, respectively. This is not found persuasive because one does not need to produce the invention of claim 13 the housing part by injection molding or by injection mold, since one can produce the gasket and then attach the gasket to the housing part.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 13-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13, line 6, "it", unclear what this stands for.

Claim 17, "gating point", unclear what applicant means by this because the gasket is capable of being formed by other method than what applicant desires. This also is true for

claims 18-19. Claim 18, “two connecting pieces extending from the gating...short sides”, this is also unclear.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bogan et al (US. 4,575,578).

Bogan discloses a housing part comprising a first component (e.g. 38), a radial seal (e.g. one of 36) formed onto the first component and composed of a second elastic component (e.g. material of 36) having a radial sealing surface (e.g. either top or side surfaces of 36), the radial seal has at least one riser dome (e.g. any portion of the 1<sup>st</sup> 44 at the middle of short sides of a rectangular housing part) formed on it and extending from the radial sealing surface in an axial direction (e.g. each of 44 extend in both radial direction and axial direction). The radial seal has at least one second riser dome (e.g. any portion of the 2<sup>nd</sup> 44 at the middle of short sides of the rectangular housing part), so that the riser domes are situated radially inside the radial sealing surface (e.g. inside of the outer most 36). The radial sealing surface has no fusion seam (e.g. no fusion seams). The radial seal is substantially rectangular (e.g. as see in figures 4-8). The housing part comprising one gating point (e.g. any point along 46) of the second component (e.g. second component having 36, 44 and 46), situated radially inside the radial seal (e.g. 46 and 44 are inside of the outer most 36). The housing part comprising two connecting pieces extending

from the gating point to a middle of long sides of the radial seal which is substantially rectangular (e.g. consider the middle one of 46 at the gating point and the other two of 46 on each side of middle 46 are connecting pieces), and two riser domes situated substantially in a middle of its short sides (e.g. the portions of 44 at the middle of the short sides). The housing part detent elements (e.g. each detent 48 around the holes 42).

Regarding claim limitations to method and/or intended use: *The housing part for a drive unit, the housing part for sealing the housing in a watertight fashion (intended use limitations), the housing part and the radial seal are produced by an injection molding process, the radial sealing surface has no fusion seam, the housing part comprising one gating point, two connecting pieces extending from the gating point to a middle of long sides of the radial seal which is substantially rectangular (e.g. method limitations), detents attachable to corresponding counter part detent elements for fixing said housing part in place axially, the riser domes are configured in form of axial play compensation elements equipped with an axial stop surface (intended use, the riser domes are capable of axial play compensation elements with another member, capable of providing watertight seal with a housing, with regard to the method limitations the following applies: [E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process).*

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barton et al, Paulus, Ogawa and Hayes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer H. Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. P./  
Primary Examiner, Art Unit 3676

/Vishal Patel/  
Primary Examiner, Art Unit 3676